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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,901

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Joetta Renee Palmer

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COOK ALEX LTD

SUITE 2850

200 WEST ADAMS STREET

CHICAGO, IL 60606

EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,901	Applicant(s) PALMER ET AL.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/19/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 43-70, drawn to method for separating tissue, are pending in this present application.
2. This Office action is in response to the amendment filed on 3/19/09.

Response to Amendments

3. The specification has been amended to overcome previous objection, therefore, the objection is hereby withdrawn.
4. Applicant arguments with respect to independent claims 43 and 55 that Boyd et al. fail to disclose the claimed subject matter include using a dissector having a position indicator near the dissection surface and monitoring such a position indicator through the tissue in the disclosed methods have been fully considered and persuasive, therefore, the rejection is hereby withdrawn. However, upon further search and consideration claims 43-70 are rejected in view of new ground of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for

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patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 43, 44, 46, 48, 50, 53, 55, 56, 65, and 66 are rejected under 35 U.S.C. 102(e) as being anticipated by Kerr (US 7056329).**

7. Kerr discloses (Figs. 1-2) a method for separating a tissue at a selected site comprising: positioning a dissection surface 26 of a dissector 16 near to selected tissue, the dissector including an elongated shaft with a dissecting surface 26 at a distal end or a position indicator and a viewing device or a guide; advancing the dissecting surface 26 through the selected tissue to create a desired dissection path; monitoring the position indicator through the tissue via the viewing device and simultaneously articulating the dissecting surface 26 relative to the shaft (col. 6, lines 30-65).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. **Claims 43, 45-47, 49-55, and 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 2004/02/04734 A1) in view of Levin (US 5649957).**
11. Wagner discloses (Figs. 2, 3 and 7) a method for separating a tissue at a selected site comprising: positioning a dissection surface of a dissector 290 near to selected tissue, the dissector including an elongated shaft 280 with a dissecting surface at a distal end 282, wherein the distal end 282 includes a light indicator; advancing the dissecting surface through the selected tissue to create a desired dissection path (paragraphs [0091]-[0098]). Boyd also discloses the dissector further includes a working lumen and a port for the purpose of delivering the pharmacological agent, for example, saline solution, phosphated buffer solution, an analgesic, an antibiotic, a hemostatic agent, an anti-inflammatory, or other useful drug or fluid, thereby, improving wound healing (paragraph [0040]). Wagner discloses the invention substantially as claimed except for the step of simultaneously articulating the dissecting surface relative to the shaft.

12. However, Levin discloses the distal portion of the tissue dissector should be articulated for the purpose of allowing the surgeon to articulate the distal portion without removing the dissector from the body cavity in which the dissector is being utilized, thus saving time and effort during surgery (col. 4, lines 1-14). Given the teachings, it would have been obvious to one of ordinary skill in the art to incorporate the teachings as disclosed by Levin into the device of Boyd so that it too would have the same advantage.
13. **Claims 43, 45-47, 49-55, and 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner and Levin as applied to claims 43 and 55 above and further in view of Boyd et al. (Pub No. US 2002/0087183).**
14. The modified device and method of Wagner discloses the invention substantially as claimed except for the guide. However, Boyd et al. discloses the distal tip 144 of the shaft of the tissue dissector should includes a hole for carrying a silastic tape 146 or elastomeric tube to retract the main pulmonary artery during a coronary artery bypass surgery (paragraph [0091]). It would have been obvious to one of ordinary skill in the art to incorporate the guide as disclosed by Boyd into the distal tip of the modified device of Wagner to improve the utility of the modified device of Wagner.
15. **Claims 43-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd et al. (Pub No. US 2002/0087183) in view of Wagner (US 2004/02/04734 A1) further in view of Levin (US 5649957).**

16. Boyd discloses (Figs. 22-51) a method for separating a tissue at a selected site comprising: positioning a dissection surface of a dissector 140 near to selected tissue, the dissector including an elongated shaft 141 with a dissecting surface at a distal end 144, wherein the distal end 144 includes a guide; advancing the dissecting surface through the selected tissue to create a desired dissection path (paragraphs [0091]-[0098]). Boyd discloses the invention substantially as claimed except for the step of monitoring the position indicator through the tissue and simultaneously articulating the dissecting surface relative to the shaft and a working lumen.
17. However, Wagner discloses a surgical dissection tool should be malleable into any shape desired by the clinician (paragraph [0039]) and it should includes a light indicator and working lumen and a port for the purpose of delivering the pharmacological agent, for example, saline solution, phosphated buffer solution, an analgesic, an antibiotic, a hemostatic agent, an anti-inflammatory, or other useful drug or fluid, thereby, improving wound healing (paragraph [0040]). Further, Levin discloses the distal portion of the tissue dissector should be articulated for the purpose of allowing the surgeon to articulate the distal portion without removing the dissector from the body cavity in which the dissector is being utilized, thus saving time and effort during surgery (col. 4, lines 1-14). Given the teachings, it would have been obvious to one of ordinary skill in the art to incorporate the teachings, as disclosed by Wagner and Levin, into the device of Boyd so that it too would have the same advantage.

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18. Referring to claims 52 and 67, Boyd as modified by Wagner/Levin discloses using a dissector for performing steps of treating atrial fibrillation and creating a path between a pair of pulmonary veins and pericardium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
4/6/09